

Remarks

I. Status of the Application

Claims 1, 4-12, and 29-31 are pending in the application. Claims 4 and 29 are amended.

II. Claim Rejections - 35 USC § 112

Claim 29 has been rejected under 35 U.S.C. 112 as being allegedly indefinite.

The Examiner repeated that it was unclear why the “first” and “second” investment “choices” recited in claim 29 are not second and third investment choices. However, claim 29 no longer refers to “choices,” it refers to accounts. Regardless, claim 29 has been amended to recite that “the investment preference information includes the first investment account and a second investment account.” Antecedent basis for the first investment account is found in claim 1, which recites “an investment account.”

While it is believed that it is clear that the limitation “identifying investment-preference information” in claim 29 is the same as the limitation “identifying, by the computer, investment-preference information” in claim 1, claim 29 has been amended to recite “identifying, by the computer, investment-preference information associated with the user in response to receiving the request,” so that the recitations are identical. This limitation of claim 29 goes on to modify the corresponding limitation of claim 1 by further reciting that “the investment-preference information includes the first investment account and a second investment account, the first investment account and the second investment account being designated by the user.” Since this limitation of claim 29 modifies an existing limitation of claim 1, it is believed that the term “comprising” is appropriate.

Amended claim 29 is believed to be clear. Withdrawal of the rejection and reconsideration of the claims are respectfully requested.

III. Claim Rejections - 35 USC § 103

Claims 1, 4-12, and 29-31 have been rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent No. 6,112,191 (“Burke”) in view of U.S. Patent No. 6,164,533 (“Barton”).

A. Independent Claims 1 and 30

Independent claim 1, which defines a method for effectuating an investment, requires in part, “completing a point-of-sale transaction by a user at a point of sale location,” receiving “a request to complete an on-demand investment transaction after completion of the point-of-sale transaction,” and transferring “a predetermined monetary investment amount determined prior to start of the point of sale transaction.”

Independent claim 30 requires, in part, “completing a first, point-of-sale transaction by a user at a point of sale location,” and “receiving, by a computer, a request to conduct a second, separate, on-demand investment transaction after completion of the first, point-of-sale transaction”.

As discussed in more detail in the Amendment filed on March 30, 2006, requiring that the “request” to complete an investment transaction be received after completion of the point-of-sale transaction, as in claims 1 and 30, is a very important consideration for merchants and banks, which is not taught or suggested in the cited prior art. Since the request is received after completion of the point of sale transaction, the point-of-sale transaction and the investment transaction are two separate transactions, which facilitates processing of the point-of-sale transaction and simplifies accounting for the merchant. If the investment transaction is part of the point-of-sale transaction, in contrast, as in the cited prior art discussed below, the risk of delay and/or interruption of the clearance and settlement of the point-of-sale transaction, as well as exceeding a user’s credit limit, is increased. The requirement that the amount of money to be

transferred be a predetermined amount determined prior to the point-of-sale transaction in claim 1 assists the user in planning and avoids surprises. For example, if the investment contribution is a percentage of the purchase price, as in the prior art, a surprisingly large contribution may result from a large purchase.

Burke discloses a method of accumulating credits in a consumer's surplus accounts from financial transactions between a consumer and a merchant, in which an "excess amount" for investment is added to a purchaser's "transaction amount" to create a "total withdrawal." (Col. 11, lines 37-39; Col. 14, lines 28-34; Col. 15, lines 15-19; Col. 16, lines 34-35). The purchaser decides how much money to add to the purchase price for investment (the "excess amount"). The excess amount is allocated among various accounts previously specified by the consumer, and the total withdrawal (purchase amount and investment amount) is cleared by the bank during the point-of-sale transaction. (Col. 11, lines 39-43; Col. 13, lines 31-34; Col. 14, lines 16-31; Col. 15, lines 20-21; Col. 16, lines 36-37). The Examiner admits that Burke "does not specifically teach that the investment-preference information includes any predetermined monetary investment amount for the on-demand investment as the investment amount is specified at the point-of-sale location at the time of the sale, nor does the disclosure of Burke include that the investment transaction occurs after completion of the point-of-sale transaction."

Since all the claim limitations require that the point-of-sale transaction be completed and/or the predetermined monetary investment amount, none of the limitations of claim 1 and claim 30 are present in Burke. Burke should not, therefore, be the primary reference in an obviousness rejection.

Barton discloses a system for automatically contributing monies to a savings program ("AutoIRA") upon making a purchase, wherein charges are tallied to include "the amount of

purchase, local and government taxes, and AutoIRA contribution.” In one example, the contribution amount is calculated as a percentage of the purchase price. (Col. 5, lines 5-8). In another example, the contribution is a difference between the total purchase amount and a rounded up dollar value. (Col. 5, lines 8-11). In a third example, a user presents one or more coupons at the point-of sale, depending on how much money the user wants to contribute. (Col. 5, lines 11-14). In no case does Barton transfer a predetermined monetary investment amount “determined prior to start of the point-of-sale transaction,” as the Examiner asserts. The Examiner does not assert that Barton teaches receiving a request to complete an on-demand investment transaction after completion of the point-of-sale transaction. None of the limitations of claim 1 are therefore shown in Barton, either.

The MPEP requires that: “the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” (MPEP § 2143, citing *In re Vraeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner does not identify in the prior art the limitation of “receiving, by a computer, a request to complete an on-demand investment transaction after completion of the point-of-sale transaction.” The Examiner merely asserts that it would have been obvious to do so to avoid a problem identified by the applicant in the Amendment dated March 30, 2006, because it is allegedly “well-settled that constructing a formerly integral structure in various elements involves only routine skill in the art,” citing *Nerwin v. Erlichman*, 168 USPQ 177, 179 (BPI 1969) (“Nerwin”).

According to the MPEP: “The examiner must apply the law consistently to each application after considering all the relevant facts. If the facts in the prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.” (MPEP § 2144). It is respectfully submitted that the facts of Nerwin are not sufficiently similar to the present rejection to support its application here.

The issue in Nerwin was “whether or not in view of the pertinent prior art, the substance of the count makes obvious to one ordinarily skilled in the art the substance of the patent claim, or vice versa.” The subject matter was a non-camera photographic apparatus. The Board in Nerwin only stated that the “mere fact that a given structure is integral does not preclude its consisting of various elements.” It did not find that a structure comprising various elements is always obvious in light of an integral structure, as the Examiner implies.

Furthermore, the technology in Nerwin is completely different than the technology claimed. While an “integral” mechanical structure may be identified and separated into structural parts in an apparatus such as that in Nerwin, it is not clear that a financial method has an “integral structure” or how to separate it into its “various elements.” In the present case, the financial methods of Burke cannot be so simply separated into constituent elements. Nerwin is not, therefore, relevant to the present claims.

Furthermore, even if Nerwin is relevant, more is required to derive the missing limitation “receiving, by a computer, a request to complete an on-demand investment transaction after completion of the point-of-sale transaction” than somehow deconstructing the financial methods in Burke. The Examiner has not demonstrated how separating the financial methods of Burke would yield the limitation missing from Burke. Since the Examiner admits that this limitation is

missing in Burke, the limitation cannot appear by merely separating the method into constituent elements, as the Examiner proposes.

It is also noted that even if the problem of exceeding credit limits due to the investment was recognized (which the Examiner has not shown), such recognition could lead to other solutions besides that claimed. For example, in such cases, the investment portion of the transaction could be cancelled or postponed. Postponement is suggested by Burke at column 3, line 44-46 for example. Cancellation is suggested by Burke at column 6, lines 36-40, for example. These options are much simpler than always performing a separate transaction for the investment, as claimed. It is therefore only with hindsight that the Examiner could have identified the proposed modification to Burke. The MPEP states that: “impermissible hindsight must be avoided and the legal conclusion [of obviousness] must be reached on the basis of facts gleaned from the prior art.” (MPEP § 2142).

For the reasons set forth above, claims 1 and 30 and the claims dependent upon them would not, therefore, have been obvious in light of the cited art.

Withdrawal of the rejection and reconsideration of the claims are respectfully requested.

B. Dependent Claim 4

Claim 4, which is dependent on claim 1, has been amended to recite accumulating “a plurality of requests to complete on-demand investment transactions” until a predetermined completion time. Burke does not accumulate the on-demand investment requests until a predetermined completion time, as the Examiner asserts. Burke only accumulates the value of excess funds provided to a merchant in cash or by check, in off-line (non-credit card) transactions. (Col. 3, lines 4-13). Burke does not accumulate requests to transfer funds in credit or debit card transactions.

Claim 4 would not, therefore, have been obvious in light of Burke and Barton.

Withdrawal of the rejection and reconsideration of the claim are respectfully requested.

C. Claim 9

Independent claim 9 requires “prompting a user at a point-of-sale location, to request that an on-demand investment transaction be performed, after completion of a point of sale transaction,” and “receiving, by a computer, the request from the user at the point-of-sale location.” Claim 9 further requires “causing, by the computer, funds to be transferred to an investment account, wherein the funds equal a predetermined monetary investment amount determined independently of a purchase amount of the point-of-sale transaction, upon receipt of the request from the user.”

The Examiner’s comments concerning claim 9 do not address these limitations. The portion of Burke cited by the Examiner is not relevant. Neither Burke nor Barton teach or suggest “prompting a user at a point-of-sale location, to request that an on-demand investment transaction be performed, after completion of a point of sale transaction,” or “receiving, by a computer, the request from the user at the point-of-sale location,” as discussed above.

Claim 9 and the claims dependent upon it would not have been obvious in light of the cited references.

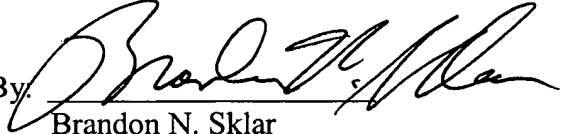
Withdrawal of the rejection and reconsideration of the claims are respectfully requested.

IV. Conclusion

Allowance of the application in light of these Amendments and Remarks is respectfully requested.

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